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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/591,108	01/24/2007	Paul John Edwards	3075-015	6377
33432 7590 12/29/2008 KILYK & BOWERSOX, P.L.L.C. 400 HOLIDAY COURT SUITE 102 WARRENTON, VA 20186				
EXAMINER YOUNG, SHAWQUITA				
ART UNIT		PAPER NUMBER		
1626				
MAIL DATE		DELIVERY MODE		
12/29/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/591,108

Applicant(s)

EDWARDS ET AL.

Examiner

SHAWQUA YOUNG

Art Unit

1626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 September 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) 35 and 36 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 7, 8, 10-14, 18-20 and 31-34 is/are rejected.
- 7) ☒ Claim(s) 5, 6, 9, 15-17 and 21-30 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 8/31/06 and 3/6/07.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claims 1-36 are currently pending in the instant application.

I. *Priority*

The instant application is a 371 of PCT/EP05/02010, filed on February 25, 2005 and claims benefit of the Foreign Application EPO 04 005 347.2, filed on March 5, 2004.

II. *Information Disclosure Statement*

The information disclosure statements (IDS) submitted on August 31, 2006 and March 6, 2007 are in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statements have been considered by the examiner.

III. *Restriction/Election*

A. Election: Applicant's Response

Applicants' election with traverse of Group I in the reply filed on September 2, 2008 is acknowledged. The traversal is on the ground(s) that: (1) that there is no serious burden on the part of the Examiner to search the entire scope of the claims from the standpoint that the searches would overlap.

All of the Applicants' arguments have been considered but have not been found persuasive. It is pointed out that the restriction requirement is made under 35 U.S.C. 121. 35 U.S.C. 121 gives the Commissioner (Director) the authority to restrict applications to several claimed inventions when those inventions are found to be independent and distinct. The Examiner has indicated that more than one independent and distinct invention is claimed in this application and has restricted the claimed

subject matter accordingly.

Applicants argue that there is not serious burden on the Examiner to search the entire scope of the claims from the standpoint that the searches would overlap. However, the Examiner wants to point out that this statement is not true. The Examiner has attempted to search the alternative group that Applicants proposed (See page 4 of the arguments) and the scope is too broad which resulted in an incomplete search. Therefore, the Examiner will search and examine Applicants elected group which is group I wherein R⁷ is C₀-C₄ alkylene connected to an optionally substituted phenyl ring and the other variables are as defined in group I in the restriction requirement.

Further, the Restriction Requirement detailed the reasons for restriction between the groups. Different search considerations are involved (i.e., class/subclass searches, databases searches, etc.) for each of the groups listed. The inventions are classified into classes 514, 544, 546 and 548. However, each Class 514, 544, 546 and 548 encompasses numerous patents and published applications. For instance, Class 514 contained 165,171 patents and published applications. Therefore it would constitute a burden on the Examiner and the Patent Office's resources to examine the instant application in its entirety. The restriction requirement is deemed proper and made final.

Subject matter not encompassed by elected Group I are withdrawn from further consideration pursuant to 37 CFR 1.142 (b), as being drawn to nonelected inventions.

IV. Rejections

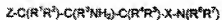
Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

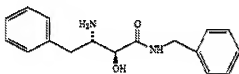
Claims 1-4, 7,8,10-14,18-20, 32 and 34 are rejected under 35 U.S.C. 102(b) as being anticipated by *Yuan, et al.* (US 5,455,271). The instant invention claims a product



with the formula
claim 1.

wherein variables are as defined in

The *Yuan, et al.* reference teaches 3(S)-amino-4-phenylbutanoate derivatives



such as

(See compound 19, column 23) and the

use of these derivatives as tight-binding inhibitors of leukotriene A4 hydrolase. This species of compound anticipates the genus compound of the instant invention, wherein the genus structure and its definitions are stated above.

Claim Rejections - 35 USC § 112, first paragraph

The following is a quotation of the first paragraph of 35 U.S.C. 112:

Art Unit: 1626

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 34 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

As stated in the MPEP 2164.01 (a), "There are many factors to be considered when determining whether there is sufficient evidence to support a determination that a disclosure does not satisfy the enablement requirement and whether any necessary experimentation is "undue".

In In re Wands, 8 USPQ2d 1400 (1988), factors to be considered in determining whether a disclosure meets the enablement requirement of 35 U.S.C. 112, first paragraph, have need described. They are:

1. the nature of the invention,
2. the state of the prior art,
3. the predictability or lack thereof in the art,
4. the amount of direction or guidance present,
5. the presence or absence of working examples,
6. the breadth of the claims,
7. the quantity of experimentation needed, and
8. the level of the skill in the art.

In the instant case,

The nature of the invention

The nature of the invention is drawn to a compound of formula (I), as defined in claim 1, for use as a medicament.

The state of the prior art and the predictability or lack thereof in the art

The state of the prior art is that the pharmacological art involves screening *in vitro* and *in vivo* to determine which compounds exhibit the desired pharmacological activities (i.e. what compounds can treat which specific disease by what mechanism). There is no absolute predictability even in view of the seemingly high level of skill in the art. The existence of these obstacles establishes that the contemporary knowledge in the art would prevent one of ordinary skill in the art from accepting any therapeutic regimen on its face.

The instant claimed invention is highly unpredictable as discussed below:

It is noted that the pharmaceutical art is unpredictable, requiring each embodiment to be individually assessed for physiological activity. In *re Fisher*, 427 F. 2d 833, 166 USPQ 18 (CCPA 1970) indicates that the more unpredictable an area is the more specific enablement is necessary in order to satisfy the statute Applicants' claims are drawn to compounds according to claim 1 for use in medicine.

Applicants' claim 34 is a broad claim that encompasses the use of the instantly claimed compounds as a medicament for the treatment of any disease or disorder associated with DPP-IV activity. Applicants have disclosed in the specification that the instant compounds can be used in the treatment or prophylaxis of for example,

neurodegenerative diseases (i.e. Alzheimer's disease).

Applicants' claims are therefore drawn to a medicament for the treatment or prophylaxis of Alzheimer's disease. It is the state of the art that there is no known cure or prevention for Alzheimer's disease and that there are only four medications available in the United States available to temporarily slow the early stages of Alzheimer's disease. The current drugs for the treatment of Alzheimer disease, Aricept, Exelon, Reminyl and Cognex, treat early stages of Alzheimer's disease by delaying the breakdown of acetylcholine. Memantine, which blocks excess amounts of glutamate treats late stage Alzheimer's disease.

(<[URL:http://www.cnn.com/2003/HEALTH/conditions/09/24/alzheimers.drug.ap/index.html](http://www.cnn.com/2003/HEALTH/conditions/09/24/alzheimers.drug.ap/index.html)>.)

In addition, Layzer, Cecil Textbook of Medicine (article enclosed), states that "some degenerative diseases are difficult to classify because they involve multiple anatomic locations" (see page 2050). Alzheimer's disease has traditionally been very difficult or impossible to prevent or even to treat effectively with chemotherapeutic agents (See e.g., the Cecil Textbook of Medicine, 20th edition (1996), Vol. 2, page 1994).

The amount of direction present and the presence or absence of working examples

The only direction or guidance present in the instant specification is minimal. There are no working examples present for the treatment of the diseases encompassed

by the broad claim 34.

Test assays and procedure are provided in the specification at pages 103-105 for DPP-IV inhibition is generally unpredictable and the data provided is insufficient for one of ordinary skill in the art in order to extrapolate to the other compounds of the claims. It is inconceivable as to how the claimed compounds can treat the extremely difficult diseases embraced by the instant claims.

Applicants have not provided any competent evidence or disclosed tests that are highly predictive for the pharmaceutical use of the instant compounds. Pharmacological activity in general is a very unpredictable area. Note that in cases involving physiological activity such as the instant case, "the scope of enablement obviously varies inversely with the degree of unpredictability of the factors involved." See *In re Fisher*, 427 F.2d 833, 839, 166 USPQ 18, 24 (CCPA 1970).

The breadth of the claims

The breadth of the claims is drawn to a compound of formula (I), as defined in claim 1, for use as a medicament.

The quantity of experimentation needed

The quantity of experimentation needed is undue experimentation. One of skill in the art would need to determine what diseases out of all conditions would be benefited by the activity of the claimed compounds and would furthermore then have to determine which of the claimed compounds in the instant invention would provide treatment of the diseases.

The level of the skill in the art

The level of skill in the art is high. However, due to the unpredictability in the pharmaceutical art, it is noted that each embodiment of the invention is required to be individually assessed for physiological activity by *in vitro* or *in vivo* screening to determine which compounds exhibit the desired pharmacological activity and which diseases would benefit from this activity.

The specification fails to provide sufficient support of the broad use of the claimed compounds of the invention to be used as a medicament. As a result necessitating one of skill to perform an exhaustive search for which diseases can be treated by what compounds of the invention in order to practice the claimed invention.

Genentech Inc. v. Novo Nordisk A/S (CA FC) 42 USPQ2d 1001, states that “a patent is not a hunting license. It is not a reward for search, but compensation for its successful conclusion” and “patent protection is granted in return for an enabling disclosure of an invention, not for vague intimations of general ideas that may or may not be workable”.

Therefore, in view of the Wands factors and In re Fisher (CCPA 1970) discussed above, to practice the claimed invention herein, a person of skill in the art would have to engage in undue experimentation to test which diseases can be treated by the compound encompassed in the instant claims, with no assurance of success.

This rejection can be overcome, for example, by deleting claim 34.

Claim Rejections - 35 USC § 112, second paragraph

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 31-34 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 31-34 recite the limitation "prodrug" which is dependent on claim 1 but "prodrug" is not found in claim 1. There is insufficient antecedent basis for this limitation in the claim.

Claim 33 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the terms "insulin mimetics", "GIP mimetics", "GLP mimetics" and "PCAP mimetics" have not been clearly defined in the specification to know the metes and/or bounds of the term and the Examiner is unclear to what agents are being included or excluded by the above terms. Applicants can overcome the rejection by deleting the above terms in claim 33.

V. Objections

Claim Objections

Claim 30 is objected to because of the following informalities: the term "and" is

missing between the last two structures in claim 30 and the claim is missing a period.
Appropriate correction is required.

Dependent Claim Objections

Dependent Claims 2-34 are also objected to as being dependent upon a rejected based claim. To overcome this objection, Applicant should rewrite said claims in an independent form and include the limitations of the base claim and any intervening claim.

Claim Objection-Non Elected Subject Matter

Claims 1-34 are objected to as containing non-elected subject matter. To overcome this objection, Applicant should submit an amendment deleting the non-elected subject matter.

Specification

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

The abstract of the disclosure is objected to because the abstract contains the term "said". Correction is required. See MPEP § 608.01(b).

VI. Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shawquia Young whose telephone number is 571-272-9043. The examiner can normally be reached on 7:00 AM-3:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph M^{re}Kane can be reached on 571-272-0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Shawquia Young/
Examiner, Art Unit 1626

/Rebecca L Anderson/
Primary Examiner, Art Unit 1626

